

**T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT**

Date:  APPL. S. N:   
 To Examiner:  Art Unit:   
 From:  Return This Memo To: Case   
 PARALEGAL SPCECIALIST Drop-Off Location

**SUBJECT:** Decision on Terminal Disclaimer(T.D.) filed:

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete,

please initial, date and return this memo to me. THANK YOU.

- ☐ The T.D. is PROPER and has been recorded (see 14.23).
- ☒ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see 14.24):
- ☒ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see 14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see 14.27.01).
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see 14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney "of record" (see 14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see 14.28).
    - ☐ is not recognized as an officer of the assignee (see 14.29 & possible 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see 14.30).
  - ☐ The T.D. is not signed (see 14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see 14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see 14.26, 14.27.02 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see 14.26, 14.27.02 or 14.26.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex.Initials: \_\_\_\_\_ Date: \_\_\_\_\_

Log Date: \_\_\_\_\_

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(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/820,553 )  
Confirmation : 8366 )  
Applicants : Fischer et al. )  
Filed : April 8, 2004 )  
Title: TRANSDERMAL DELIVERY )  
SYSTEM (TDS) WITH ELECTRODE )  
NETWORK )  
Art Unit : 3767 )  
Examiner : GILBERT, Andrew M. )  
Atty Docket : 29473/11372A )  
Customer No. : 04743 )

**TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Novosis Pharma AG (hereinafter "Assignee"), is the assignee of the entire right, title, and interest in the above-identified patent application as shown by the assignment recorded on December 19, 2006, at Reel 018655, Frame 0672, and U.S. Patent No. 6,757,560, as shown by the assignment recorded on February 9, 2001, at Reel 011519, Frame 0494.

Assignee hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on this application extending beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent No. 6,757,560, and hereby agrees that any patent so granted on this application shall be enforceable only for and during such period that said patents are commonly owned, this agreement to run with any patent granted on this application and to be binding upon assignee and its successors or assigns.

Assignee does not disclaim any terminal portion of any patent granted on this application prior to the expiration date of the full statutory term as defined in 35 U.S.C. §§154 to 156 and 173 of U.S. Patent No. 6,757,560, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 6,757,560 later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part or is terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The documents establishing the assignee's chain of title have been reviewed by the undersigned and the undersigned certifies that, to the best of his knowledge and belief, title is in the assignee.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

August 30, 2007

By: 

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| <b>Application Number</b><br> | <b>Application/Control No.</b><br>10/820,553 | <b>Applicant(s)/Patent under Reexamination</b><br>FISCHER ET AL. |  |
| <b>Document Code - DISQ</b>  |  | <b>Internal Document – DO NOT MAIL</b>                           |  |

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|---------------------------------|---|--|
| <b>TERMINAL<br/>DISCLAIMER</b>  | <input type="checkbox"/> <b>APPROVED</b>              | <input checked="" type="checkbox"/> <b>DISAPPROVED</b> |
| Date Filed : August 30,<br>2007 | This patent is subject<br>to a Terminal<br>Disclaimer |  |

|                                 |
|---------------------------------|
| <b>Approved/Disapproved by:</b> |
| Henry D. Jefferson              |